

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 3-10, 12-15, 18-33 and 35-36 are presently active in this case. The present Amendment amends Claims 20, 26 and 30 and introduces new Claims 35-36 without introducing any new matter.

The outstanding Office Action rejected Claims 20 and 26 under 35 U.S.C. §112, second paragraph, as indefinite. Claims 3-10, 12-15, 20-28 and 30-32 were rejected under 35 U.S.C. §103(a) as unpatentable over McHale, IV et al. (U.S. Publication No. 2002/0038165, herein "McHale") in view of Smith (U.S. Patent No. 5,826,043, herein "Smith"). Claim 18 was rejected under 35 U.S.C. §103(a) as unpatentable over McHale and Smith and further in view of Todd (U.S. Patent No. 6,072,393). Claim 19 was rejected under 35 U.S.C. §103(a) as unpatentable over McHale and Smith and further in view of Duphorne (U.S. Patent No. 6,212,265). Claim 29 was rejected under 35 U.S.C. §103(a) as unpatentable over McHale and Smith in view of Kono (U.S. Patent No. 6,229,694).

First, Applicant wishes to thank Examiner Fischer for the courtesy of an interview granted to Applicant's representative on September 12, 2005, at which time the filing date of the reference McHale was discussed.

Accordingly, Applicant files herewith two certified translations of the Japanese Priority documents 11-233,655, filed on August 20, 1999 and 2000-119,233, filed on April 20, 2000, to perfect claim to priority, in accordance with 37 C.F.R. §1.55 and MPEP §201.15.

In response to the rejection of Claims 20 and 26 under 35 U.S.C. §112, second paragraph, Claims 20 and 26 are amended to correct the noted informalities. In particular, Claim 20 is amended to recite "an internet or a communications network."¹ Claim 26 is

¹ Finds support in Applicant's disclosure as originally filed, for example in original Claim 20 and from page 10,

amended to recite “at least one of the portable table top terminal and the counter top terminal is configured to indicate material information selected from the group consisting of.”

Further, Claim 30 is amended to correct minor formalities. Since the changes are only of formal in nature or find support in the Specification as originally filed, they are not believed to raise a question on new matter.

In view of amended Claims 20 and 26, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

In response to the rejection of Claims 3, 28 and 30 under 35 U.S.C. §112, second paragraph, Applicant respectfully traverses the rejection, since these claims are drafted in proper form using the transition phrase “comprising” in the preamble.² The term “comprising” define the scope of a claim with respect to what unrecited additional components, if any, are excluded from the scope of the claim.

In response to the rejections of Claims 3-10, 12-15 and 18-33 under 35 U.S.C. §103(a), Applicant respectfully requests reconsideration of these rejections and traverses the rejections, as discussed next.

Applicant respectfully submits that the reference McHale does not qualify as prior art against the present Application. The present Application has a U.S. filing date of August 15, 2000 and claims priority to the Japanese Patent Application 11-233655 filed on August 20, 1999 and to the Japanese Patent Application 2000-119233, filed on April 20, 2000.

line 29 to page 11, line 1.

² See MPEP §2111.03, page 2100-52, “The transitional term “comprising”, which is synonymous with “including,” “containing,” or “characterized by,” is inclusive or open-ended and does not exclude additional, unrecited elements or method steps... See *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) (“Comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.).”

Accordingly, Applicant respectfully requests withdrawal of the McHale reference from consideration, since McHale is not prior art because it has a 35 U.S.C. §102(e) date of November 6, 2001, which is well after August 15, 2000. Even if the teachings of the parent application with the serial no. 09/613,117, to which McHale is a continuation-in-part CIP, supports the teachings of McHale to form the rejection, both Japanese priority documents have been filed before the filing date of the parent case 09/613,117 of McHale. Therefore, all outstanding rejections which rely on McHale must be withdrawn.

Accordingly, Claim 3 is amended to delete the features to recite “and including a number reading part configured to enable the portable table top terminal to read an identification number of the terminal receptacle onto which the portable table top terminal is placed,” “to read the identification number of the terminal receptacle when placed on the terminal receptacle, and is further configured,” and “on the basis of the identification number.” These features were introduced by previous amendments of May 13, 2004 and November 23, 2004 to overcome the reference McHale. The deleted features are now presented in new dependent Claims 35-36.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 3-10, 12-15, 18-33 and 35-36 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
I:\ATTY\NS\03702\195821US\195821US-AM1-DRAFT2.DOC